

REMARKS

Applicants have carefully considered the September 15, 2006 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 11-20 were pending in this application. In response to the Office Action dated September 15, 2006, withdrawn claims 11-18 have been canceled and claim 19 has been amended. New claims 21-25 have been added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification, including page 13, line 26 through page 15, line 12. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Applicants respectfully request the Examiner to consider the Information Disclosure Statement filed concurrently herewith. The Examiner is requested to forward Applicants an appropriately initialed copy of the PTO-1449 form with the next Office communication.

Claims 19 and 20 were rejected under 35 U.S.C. § 102 as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over any of Conder et al. (U.S. Pat. No. 4,105,292), Neudeck (U.S. Pat. No. 6,461,003) or Chen et al. (U.S. Pat. No. 6,497,925). Applicants respectfully traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically

claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). There are significant differences between the claimed invention and the devices disclosed by Conder, Neudeck or Chen that would preclude the factual determination that Conder, Neudeck or Chen identically describes or suggests the claimed inventions within the meaning of 35 U.S.C. §§ 102 or 103.

First, with respect to independent claim 19, it appears that the Examiner has not construed the claim, particularly the “means for embossing a pattern of rectangularly-shaped or sinusoidally-shaped recesses” element within the construct dictated by 35 U.S.C. § 112, ¶ 6, that is, the Examiner has not considered Applicants’ disclosure in determining the recited structure for performing the claimed function. The Federal Circuit has held that the PTO is not exempt from the rigors of paragraph six of section 112, stating that “paragraph six applies regardless of the context in which the interpretation of means-plus-function arises.” *In re Donaldson*, 16 F.3d 1189, 1195, 29 U.S.P.Q.2d 1845, 1849 (Fed. Cir. 1994); *see also In re Morris*, 44 U.S.P.Q.2d 1023 (Fed. Cir. 1998) (following *Donaldson*). The Patent Office, recognizing this directive from the Federal Circuit, directed its examiners to “interpret a 35 U.S.C. 112, sixth paragraph ‘means or step plus function’ limitation in a claim as limited to the corresponding structure, materials or acts described in the specification and equivalents thereof.” M.P.E.P. § 2181 (August 2001).

The broadest reasonable interpretation that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the Examiner may not disregard the structure, materials or acts disclosed in the specification corresponding to such language when rendering a patentability determination. *Donaldson*, 16 F.3d at 1194-95, 29 U.S.P.Q.2d at 1850.

Here, however, it is respectfully submitted that the Examiner has not looked to the specification to determine what structure, materials or acts correspond to the recited means-plus-function element. In claim 19, the means for embossing a pattern of rectangularly-shaped or sinusoidally-shaped recesses includes a stamper adapted to emboss a textured pattern that has a plurality of rectangularly-shaped or sinusoidally-shaped recesses in the landing zone of the substrate surface. Accordingly, the Examiner has disregarded the present disclosure when he rendered his patentability determination of claims 19 and 20, and further, none of disclosures of the applied art, as described in detail below, can be seen as the same as or equivalent to the present invention. Thus, the Examiner is respectfully requested to reconsider and withdraw the rejection over claims 19 and 20.

Conder discloses a device comprising a surface with scattered projections randomly spaced on then surface of the device. See Fig. 3 and col. 2, lines 3-6 and col.3, lines 51-59. Thus, Conder fails to disclose or suggest a stamper adapted to emboss a pattern, much less a pattern of rectangularly-shaped or sinusoidally-shaped recesses in a landing zone of a substrate surface.

Neudeck discloses a device adapted to form corner cube structures in a surface. See Figs. 1-2 and col. 6, lines 51-62 of Neudeck. Thus, Neudeck fails to disclose or suggest a stamper adapted to emboss a pattern of rectangularly-shaped or sinusoidally-shaped recesses in a landing zone of a substrate surface.

Chen, at col. 3, lines 2-6, discloses a stamper adapted to produce a pattern on a surface of a substrate, wherein the pattern to be embossed is a combination of dots, lines and grooves in either radial, spiral or circumferential directions. Chen's stamper is, not adapted to emboss a pattern of rectangularly-shaped or sinusoidally-shaped recesses in a landing zone of a substrate surface.

The above argued difference between devices of Conder, Neudeck and Chen and the stamper of independent claim 19, undermines the factual determination that Conder, Neudeck or Chen discloses the stamper identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 86 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection under 35 U.S.C. § 102 for lack of novelty as evidenced by Conder, Neudeck or Chen is not factually viable and, hence, solicit withdrawal thereof. Moreover, Applicants, submit that the imposed rejection under 35 U.S.C. § 103 for obviousness predicated upon Conder, Neudeck or Chen is not factually or legally viable and, hence, solicit withdrawal thereof.

Newly added independent claim 21 is believed to be patentably distinct over the art of record. Applicants submit that none of the art of record discloses or suggests a stamper for embossing at least one pattern of recesses in a surface of a substrate for a magnetic recording medium. The stamper of claim 21 includes a stamping surface including a pattern of rectangularly-shaped or sinusoidally-shaped protrusions, wherein the pattern of rectangularly-shaped or sinusoidally-shaped protrusions is a negative image of the pattern of recesses to be embossed in the surface of the substrate.

It is believed that pending claims 19-25 are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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